

Serial No.: 09/477,943



PATENT

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Sara Wyrens

Applicant: JE-HSIUNG LAN

Serial No.: 09/477,943

Title: PLANAR OPTICAL IMAGE SENSOR AND SYSTEM FOR GENERATING AN ELECTRONIC IMAGE OF A RELIEF OBJECT FOR FINGERPRINT READING

Filed: 01/05/2000

Atty Docket No.: 12913-0013

RECEIVED

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Technology Center 2600

RESPONSE

Post Office Box Non-Fee Amendment

Assistant Commissioner for Patents

Washington, D.C. 20231

Newport Beach, CA

92660-6441

December 5, 2002

Sir:

In response to the Office Action dated September 5, 2002, the time period for responding to which having been extended by the accompanying petition for extension of time, applicant responds as follows:

The Office Action is in the nature of a Restriction Requirement. However, the Examiner is apparently requiring restriction of the claims to certain patentably distinct species shown by figures and embodiments in the drawings. There is no indication in the Restriction Requirement as to which claims the Examiner believes are directed to what inventions. Nor is there any indication as to which figures are related to which species. Clarification is requested.

Notwithstanding the foregoing, applicant elects prosecution of claims 1-41 of the present application, inasmuch as claims 2-41 all depend ultimately from independent claim 1.

This election is made with traverse since applicant is unable to discern just how the Examiner is organizing the allegedly patentably distinct species.

The Examiner is referred to §803 of the Manual Of Patenting Examining Procedure (MPEP) which defines under what circumstances restriction is proper. §803 states, in pertinent part, "under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and

they are independent or distant.” It is improper to require restriction to purported species exemplified by drawing figures. The Examiner is not entitled to determine what the invention is by examining drawings. Rather, applicant is entitled to define the invention by claiming it.

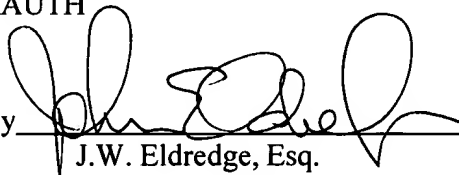
Further, the entire application is directed to a particular inventive concept, i.e., an optical sensor module which is constructed in a particular fashion to serve a particular purpose. That purpose is for detecting a presence of a relief object, such as a fingertip, and generating an electronic image of the relief object. As stated in § 803 of the MPEP, “if the search and examination of an entire application can be made with out serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Accordingly, since each and every claim of the application is directed to either an optical image sensor or a method for generating an electronic representation of a relief object using an optical image sensor, applicant submits that a search and examination which is directed to the subject matter of any of the claims would result in the development of art that is equally applicable to the subject matter of all of the claims.

In view of the foregoing, and notwithstanding applicant’s provisional election of claims 1-41, applicant requests reconsideration and withdrawal of the restriction requirement, or a more particular identification of the basis for restriction as applied to the claims which the Examiner believes are directed to patentably distinct species.

Please address all correspondence to **STRADLING YOCCA CARLSON & RAUTH, IP Department, P.O. Box 7680, 660 Newport Center Drive, Suite 1600, Newport Beach, California 92660-6441.**

Respectfully submitted,

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